

REMARKS

Claims 1-17 are in the case. Applicant has added new claims 16 and 17. No new matter is introduced by the claims, see, e.g., the specification at paragraphs 33 and 34. Moreover, as the new claims depend from what Applicant submits is an allowable claim and share all the limitations of the claim, they too are allowable.

Claims 1-4 and 6-15 have been rejected under 103(a) as being unpatentable over Gotoh et al., U.S. Patent No. 5,286,781 ("Gotoh") in view of Harvie et al., U.S. Patent No. 5,693,405 ("Harvie.") Applicant respectfully traverses the rejection.

In the Office Action dated November 3, 2005, (the "Office Action") at page 4, the Examiner describes motivation for the proposed combination of the references. That motivation is to provide any advantages of Harvie's one sided matte patterned embodiment to Gotoh. Specifically, only one advantage is identified by the Examiner – to provide indicia without printing. In other words, the Examiner posits that one skilled in the art would be motivated to combine the references because he or she would desire to add indicia to Gotoh without the expense of printing.

With all due respect, the Examiner's posited motivation is hindsight reconstruction. As is well known, obviousness cannot be established by merely suggesting that it would have been obvious to one of ordinary skill in the art to modify Gotoh according to the teachings of Harvie. More specifically, as is well established, obviousness cannot be established by combining the teachings of the cited art to produce the claimed invention, absent some teaching, suggestion, or incentive supporting the combination. Neither Gotoh nor Harvie considered alone or in combination, describe or suggest the claimed combination.

In fact, the Examiner's suggestion of the proposed combination and possible motivation is undercut by a number of facts. First, independent claim 1, from which all others depend, expressly limits its scope to a "smooth surface of the first side capable of removably adhering to a textured surface having a surface roughness greater than about 150 Ra." As is noted in the background of the present disclosure at paragraph 8, Harvie cannot adhere to such surfaces. Thus, the Examiner's proposed combination is of two references teachings incompatible uses – Gotoh may be able to adhere to rough surfaces, but Harvie cannot. Indeed, by the teachings of the references, one skilled in the art would be likely to believe that adding the indicia of Harvie to Gotoh would destroy the ability of Gotoh to adhere to a rough surface as defined in the present claim. Thus, the proposed combination would appear to teach away from the claims here, rather than provide motivation for combining the claims.

The Examiner also suggests that one would want to place indicia according to Harvie when practicing Gotoh, in order to avoid the cost of printing. That motivation, however, is wholly imagined – there is nothing in Gotoh that Applicant can find about providing any indicia and/or printing. Nor can it be fairly argued by the examiner that printing is more costly and troubling than the proposed indicia –there is no evidence, teaching, suggestion nor disclosure of such a position.

Moreover, the claims at issue here go to a rough surface – not the use of printing. In other words, the claims here say nothing about printing, and the Examiner's suggestion that the claims are obvious in light of a motivation to add printing to a film really comes nowhere near the teachings of the present claims.

In summary, the proposed motivation fails for at least two reasons. First, one skilled in the art would likely conclude that the rough surface adhesion ability of Gotoh would likely be destroyed if the proposed combination was attempted. Second, there is nothing in the references supporting the Examiner's position that printing is more difficult and costly than providing indicia, and Gotoh has no mention of providing indicia nor printing nor roughness.

It is submitted that the Examiner has not pointed to any prior art that teaches or suggests to combine the disclosures, other than Applicants' own teaching. The Section 103 rejection is based on a combination of teachings selected from multiple patents in an attempt to arrive at the claimed invention. Since there is no teaching nor suggestion in the cited art for the claimed combination, the Section 103 rejection appears to be based on a hindsight reconstruction in which isolated disclosures have been picked and chosen in an attempt to deprecate the present invention.

As the Federal Circuit has recognized, obviousness is not established merely by combining references having different individual elements of pending claims, *Ex parte Levengood*, 28 U.S.P.Q.2d 1300 (Bd. Pat. App. & Inter. 1993). MPEP 2143.01. Rather, there must be some suggestion, outside of Applicant's disclosure, in the prior art to combine such references, and a reasonable expectation of success must be both found in the prior art, and not based on Applicant's disclosure, *In re Vaeck*, 20 U.S.P.Q.2d 1436 (Fed. Cir. 1991.) In the present case, neither a suggestion or motivation to combine the prior art disclosures, nor any reasonable expectation of success has been shown.

Accordingly, Applicant respectfully requests that withdrawal of the rejection to independent claim 1, and its base claims 2-4 and 6-15, and early allowance of all claims.

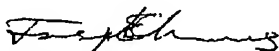
The Examiner has also rejected claim 5 over Gotoh, in view of Harvie and Okumura, U.S. Patent No. 6,407,788 ("Okumura.") Applicant respectfully traverses the rejection. Claim 5 depends from claim 1 and shares all the limitations of the base claim. As Applicant has noted above, there is no motivation for the proposed Gotoh-Harvie combination. The addition of Okumura does not cure the failure of the proposed Gotoh-Harvie combination. Accordingly, Applicant respectfully requests the withdrawal of the rejection to claim 5 and early allowance of the claim.

CONCLUSION

Claims 1- 17 define patentable subject matter over the art of record and are not anticipated by nor obvious in view of the references of record. A Notice of Allowance is respectfully solicited.

Respectfully Submitted,

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